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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,744	01/30/2004	Christian Bauer	713-1004	5715
33712	7590	04/17/2006	EXAMINER	
LOWE, HAUPTMAN, GILMAN & BERNER, LLP (ITW) 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314			WUJCIAK, ALFRED J	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/767,744

Applicant(s)

BAUER, CHRISTIAN

Examiner

Alfred Joseph Wujciak III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-24, 26-29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-24, 26-29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is the final Office Action for the serial number 10/767,744, RETAINING MEMBER, filed on 1/30/04.

#### ***Specification***

The disclosure is objected to because of the following informalities: the specification fails to provide reference number for the connecting element.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 39, lines 1-2, "wherein the connecting element extends through a thickness of the harder material of said holding portion" is indefinite because the examiner does not understand how it is possible for the connecting element to extend through a thickness of the harder material of the holding portion. The specification did not explain or describe of how connecting element extends though the holding portion. The drawing shows that the connecting is located on the outside of the holding portion and does not extend through it.

Claims 40-41 are rejected as depending on rejected claim 39.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24, 26-29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent # 6,708,931 to Miura.

Miura teaches a retaining member comprising a holding portion (1) being attachable to the support (B) and comprising a recess (30a) for holding the elongated element (P) therein. The member includes a resilient contact portion (11b) disposed on the underside of the holding portion to define a lowermost portion of the retaining member. The holding portion comprises a base portion (21) and at least an arm (27) extending laterally from the base portion. The arm has therein the recess. The arm extends laterally away from the base portion and obliquely upwardly from the resilient contact portion. The arm has a lower surface, which is flat and slanted upwardly from the underside of the base portion. The holding portion comprises two arms (27 and 31) extending from laterally opposite sides of the base portion (figure 31). The base portion comprises a lower opening (23a) for receiving therein a pin (s) of the support. The resilient contact portion comprises two resilient contact elements disposed on diametrically opposed sides of the opening. The lower opening has a peripheral downwardly extending wall positioned

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between the resilient contact elements. The holding portion is made of harder material and the resilient contact portion is made of a softer material (col. 3, lines 36-43).

Miura teaches the retaining member but fails to teach the retaining member is a one-piece retaining member. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Miura's retaining member with one piece to reduce cost in the manufacturing process.

In regards to claim 27, Miura teaches the resilient contact elements but fails to teach the resilient elements have a convex lower surface. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the lower surface of resilient elements with convex as taught by Miura to provide designer's preference shape of resilient elements.

In regards to claim 28, Miura teaches the base portion but fails to teach the base portion comprising an annular shaped. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified shape of base portion to annular shaped to provide designer's preference for the shape of the base portion.

In regards to claim 32, Miura teaches the holding portion and the resilient contact portion are made of plastic material (col. 3, lines 34-43) but fails to teach the holding portion and the resilient contact portion are constructed of same plastic material. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have replaced holding portion and resilient contact portion with same plastic material to provide cost saving in the manufacturing process.

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Claims 19-20 and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura in view of US Patent Application Publication # 2002/0100623 to Thornton.

Miura teaches a retaining member comprising a holding portion (1) being attachable to the support (B) and comprising a recess (30a) for holding the elongated element (P) therein. The member includes a resilient contact portion (11b) disposed on the underside of the holding portion to define a lowermost portion of the retaining member. The holding portion comprises a base portion/mounting portion (21) and at least an arm (27) extending laterally from the base portion. The arm has therein the recess. The arm extends laterally away from the base portion and obliquely upwardly from the resilient contact portion. The arm has a lower surface, which is flat and slanted upwardly from the underside of the base portion. The holding portion comprises two arms extending from laterally opposite sides of the base portion (figure 31). The base portion comprises a lower opening (23a) for receiving therein a pin (s) of the support. The resilient contact portion comprises two resilient contact elements disposed on diametrically opposed sides of the opening. The lower opening has a peripheral downwardly extending wall positioned between the resilient contact elements. The holding portion is made of harder material and the resilient contact portion is made of a softer material (col. 3, lines 36-43).

Miura teaches the recess and the resilient contact portion but fails to teach the recess and resilient contact portion having lining and the recess and resilient contact portion are connected by lining. Thornton teaches the lining (26). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added lining to Miura's line seating and resilient contact portion to increase friction on the recess and resilient contact portion to remain in one position when mounted on surface and retaining pipe within the recess.

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In regards to claim 36, Miura in view of Thornton teaches the material of lining, resilient contact portion and connecting element (22) but fails to teach the material is softer than the holding portion. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the material to softer than the holding portion to provide designer's choice of material for the retaining member.

Miura in view of Thornton teaches the lining, resilient contact portion comprising of thermoplastic polymer (col. 3, lines 36-43) and connecting element but fails to teach the lining and connecting element comprise of thermoplastic polymer. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the lining and connecting element material to thermoplastic polymer to increase flexibility to reduce the chance of damaging the lining and connecting element.

#### ***Allowable Subject Matter***

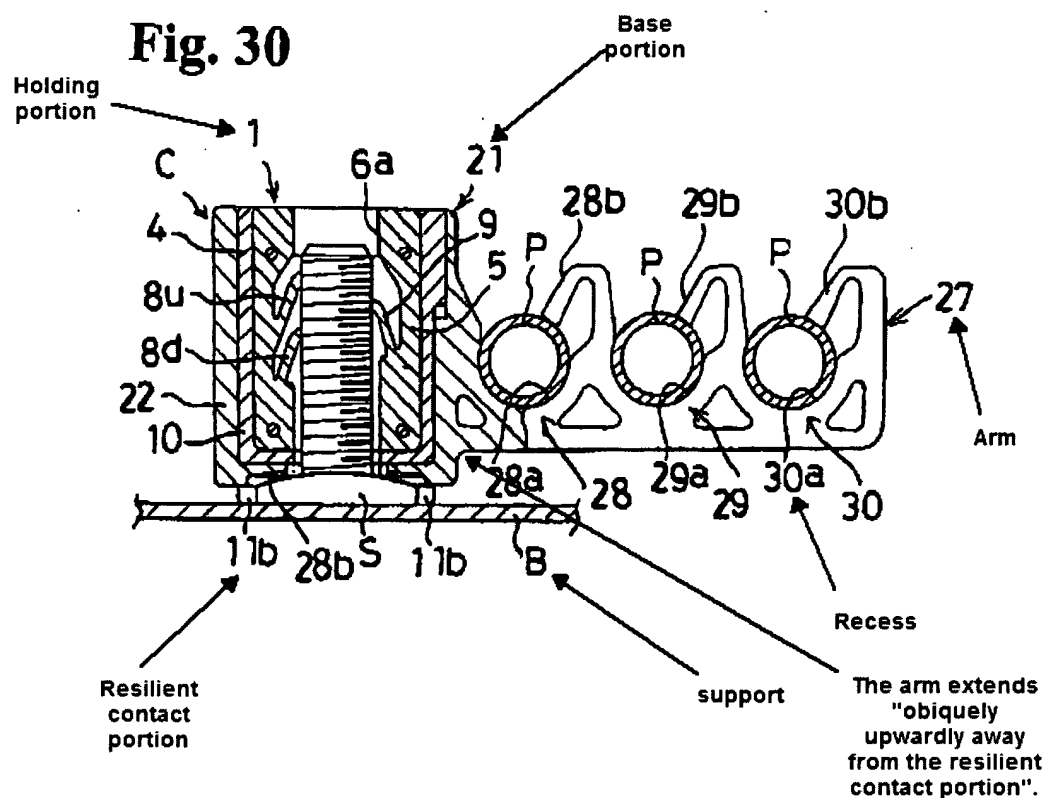
Claims 40-41 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art fails to teach the linings of the recesses of the arms are connected to the resilient contact portion by two the connecting elements which are slanted with respect to each other and define a V shape.

#### ***Response to Arguments***

Applicant's arguments filed 2/3/06 have been fully considered but they are not persuasive.

With respect to applicant argument on page 8 stating that “Miura, clearly fail to teach or suggest that the arm extends laterally away from said base portion and obliquely upwardly away from said resilient contact portion”. The examiner disagrees with the applicant because the arm (27) is clearly extending laterally away from the base portion (21) and the arm extends “obliquely upwardly away from the resilient contact portion (11b)”. The resilient contact portion is located below the base portion and the arm is above the resilient contact portion and extending away from it.



The applicant argues that convex lower surface for claims 27 and 31 is not an obvious designer's choice. Since Miura teaches the resilient elements and that it would have been an



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obvious to have modified the shape of Miura's resilient elements to convex lower surface to maintain the base portion on the support surface.

In response to applicant's argument that Thornton is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Miura and Thornton both teach clamp for mounting on a tubular object. The clamp from Miura and Thornton are in C-shaped configuration with one end opening for allowing the tubular object to be inserted therein.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Joseph Wujciak III whose telephone number is (571) 272-6827. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6815. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alfred Joseph Wujciak III  
Primary Examiner  
Art Unit 3632



4/7/06